



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,965	04/11/2001	Ihor W. Tarnawskyj	D/A0895Q	3831

7590 03/13/2003

Patent Documentation Center
Xerox Corporation
100 Clinton Ave. S.
Xerox Square 20th Floor
Rochester, NY 14644

EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/13/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/833,965	TARNAWSKYJ ET AL.
	Examiner	Art Unit
	Judy M. Reddick	1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10/21/02 & 12/11/02.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1713

DETAILED ACTION

Information Disclosure Statement

1. ***The information disclosure statement filed 10/21/02 has been considered and placed in the application file.***

Drawings

2. ***The Examiner has accepted the formal drawings filed on 11 April 2001.***

Claim Rejections - 35 USC § 102

3. ***The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:***

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. ***The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:***

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- ε3-17*
5. ***Claims 1-17 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, ε3- under 35 U.S.C. 103(a) as obvious over Hasegawa et al(as applied to claims 1-17) or Helland et al(as applied to claims 1-6 and 9-16) as per reasons stated in the previous Office Action per paper no. 2, 09/11/02, paragraph no. 7. Further, the graphite fluoride component of Hasegawa et al(col. 3, lines 29-57) and the fluorinated carbon component of Helland et al(Abstract and col. 4, lines 23+) clearly overlaps in scope with the claimed fluorinated carbon component. Further, Hasegawa et al teach phenolic resins in combination with polyacrylic acid resins & vinylbutyral polymers(col. 4,***

Art Unit: 1713

lines 11-25). As to the phenolic resins of Hasegawa et al, such are generic to and necessarily include any phenolic resin including the phenolic acrylic resin per claim 8. In any event, the use of any commercial available phenolic resin in lieu of the disclosed phenolic resin of Hasegawa et al would have been obvious to the skilled artisan and with a reasonable expectation of success. The carbon black component per each of Hasegawa et al and Helland et al is sufficient to meet the claimed secondary filler per claim 10. As to the crosslinking limitation per claim 9, it would be expected that the heated compositions of each of Hasegawa et al and Helland et al would meet this parameter. As to the volume resistivity per each of claims 14 and 15, it would be expected that the compositions of each of Hasegawa et al and Helland et al would necessarily possess this property since the compositions of each of Hasegawa et al and Helland et al are essentially the same as the claimed composition (In re Best et al, 195 USPQ 430). There is absolutely nothing on this record establishing that this, in fact, is not the case.

Response to Arguments

6. **Applicant's arguments filed 12/11/02 have been fully considered but they are not persuasive.**

Relative to Hasegawa et al and Helland et al—On the one hand, counsel argues that a developing composition as taught by Hasegawa et al and Helland et al does not have adhesive properties and on the other hand, counsel points out that the developing composition **adheres** to paper. This, in effect, substantiates the Examiner's position that the compositions of each of Hasegawa et al and Helland et al would be expected to and do possess adhesive properties. Further, while Counsel argues that the prior art houses components in excess of those as claimed, Counsel is cordially reminded that the claimed term "comprising" leaves the claim open for the inclusion of unspecified ingredients, even in major amounts (Ex parte Davis et al, 80 USPQ 448 (PTO BD. App. 1948)).

Response to Amendment

7. *After further consideration coupled with the amendments to the claims + Counsel's persuasive arguments, the rejections based on Caul et al, Ozawa et al, Eadara et al, Shaw-Klein et al, Mammino et al, Ninomiya et al and Lombardi et al are herein withdrawn.*

Conclusion

8. *The prior art to Hiratsuka et al(U.S. 3,717,576) is cited as of interest in teaching a graphite fluoride/phenolic resin/extender-containing composition similar to the claimed composition and is considered merely cumulative to the prior art supra.*

9. *THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).*

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Application/Control Number: 09/833,965

Page 5

Art Unit: 1713

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR JMD
March 5, 2003